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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/617,472

Filing Date: July 11, 2003

Appellant(s): MESTER, DAVID J.

**MAILED**  
*AUG 28 2006*  
**GROUP 3600**

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Gerald E. McGlynn, III  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 6/5/06 appealing from the Office action mailed 1/26/06.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the Supplement to Appeal Brief, filed 8/16/06, is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

5,182,705	Barr et al.	1-1993
2004/0111379	Hicks et al.	6-2004
2003/0018497	Luedtke	1-2003

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-13, 15-16, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hicks et al., U.S. Patent Application Publication No. 2004/0111379 in view of Barr et al., U.S. Patent No. 5,182,705.

As per claim 1, Hicks teaches a method of processing a customer claim against a manufacturer's product, said method includes the steps of: inputting the claim through a computer to a database at a first management level (see paragraph 0147, note that the disclosed system relies on computer input and databases to facilitate transactions, see paragraphs 0068 and 0075); determining the monetary value of the claim (see paragraph 0148); approving or denying the claim at the first management level when the monetary value of the claim is below a first predetermined level (see paragraphs 0148 and 0152). Hicks further

teaches multiple management levels involved in processing the input claims (see paragraph 0148). Hicks does not explicitly teach that second and third management levels review the input claims to approve or deny the claims when the monetary value of the claim is above a first and second level respectively. Barr teaches a system for insurance claims management in which unprocessed payments for claims are routed to the appropriate management level for review based on whether the claim amounts are above or below each management level's corresponding payment authorization amount (see column 52, lines 15-58). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these claim processing features into the warranty claims processing method of Hicks. One of ordinary skill in the art would have been motivated to incorporate these features for the purpose of facilitating the function of the top management level in Hicks to enforce the various operational standards of the other management levels (see paragraph 0072) by enabling more detailed processing of warranty claims based on their monetary value as described by Barr.

As per claim 2, Hicks in view of Barr teach the method of claim 1 as described above. Hicks further teaches a fourth management level to review all approved claims for accuracy and completeness and to inform the customer when a claim is denied and to inform an accounting management level when a claim has been approved and direct the accounting management level to reimburse the customer (see paragraph 0152).

As per claim 3, Hicks in view of Barr teach the method of claim 1 as described above. Hicks further teaches the step of inputting a claim through a computer further includes the steps of accessing the corporate database through a computer connected to a corporate network, and opening a new record file for the customer (see paragraph 0172).

As per claim 4, Hicks in view of Barr teach the method of claim 3 as described above. Hicks further teaches the step of accessing the corporate database through a computer

connected to a corporate network further includes the step of entering a predetermined login name and a predetermined password to request access (See paragraph 0170, in particular, smartcard and PIN verification).

As per claim 5, Hicks in view of Barr teach the method of claim 3 as described above. Hicks further teaches the step of accessing the corporate database through a computer connected to a corporate network further includes the steps of accessing the internet through any capably equipped computer, electronically accessing a world wide web interface to the corporate network, and electronically connecting the computer to the corporate network through the internet and world wide web connections (see column 0168).

As per claim 6, Hicks in view of Barr teach the method of claim 5 as described above. Hicks further teaches the step of electronically connecting the computer to the corporate network through the internet and world wide web connections further includes the step of entering a predetermined login name and a predetermined password to request access (see paragraph 0170, in particular, smartcard and PIN verification).

As per claim 7, Hicks in view of Barr teach the method of claim 6 as described above. Hicks further teaches the step of inputting a claim through a computer further includes the step of selecting form a menu at least one operational link to another page for input of claim specific data (see paragraphs 0147 and 0168, because the system relies on a computer interface, including a browser, and application software, it is submitted that some sort of “page,” such as a browser page, is relied upon for input of data).

Claims 8-11 recited substantially similar limitations to those already addressed in claims 3-6 with the exception that they are directed to inputting an approval or denial of the claim. Because inputting an approval or denial of a claim is taught as described above with respect to claim 1, claims 8-11 are rejected for substantially similar reasons to claims 3-6.

As per claim 12, Hicks in view of Barr teach the method of claim 11 as described above. Hicks further teaches selecting from a menu at least one operational link to another page to generate a list of all open claims (see paragraphs 0147 and 0168, because the system relies on a computer interface, including a browser, and application software, it is submitted that some sort of "page," such as a browser page, is relied upon for input of data). As described above, Hicks does not explicitly teach the additional review by the second and third management levels. However, Barr teaches a system for insurance claims management in which unprocessed payments for claims are routed to the appropriate management level for review based on whether the claim amounts are above or below each management level's corresponding payment authorization amount (see column 52, lines 15-58). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these claim processing features into the warranty claims processing method of Hicks. One of ordinary skill in the art would have been motivated to incorporate these features for the purpose of facilitating the function of the top management level in Hicks to enforce the various operational standards of the other management levels (see paragraph 0072) by enabling more detailed processing of warranty claims based on their monetary value as described by Barr

As per claim 13, Hicks in view of Barr teach the method of claim 12 as described above. As described above, Hicks does not explicitly teach the additional review by the second and third management levels. Barr further teaches selecting one claim file from the list of all open claims to select a specific claim to review (see column 52, lines 15-58, those claims identified as being above the payment authorization amount are interpreted by the Examiner to be the list of "all open claims"). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these features into the system of Hicks for the reasons given above with respect to claim 12.

Claims 15 and 16 recite substantially similar limitations to those already addressed in claims 12 and 13 with the exception that they are directed to the third management level. Because this feature has already been addressed in claim 1, these claims are rejected for similar reasons to claims 12 and 13.

Claim 18 recites substantially similar limitations to those already addressed in claims 12 and 13 with the exception that claim 18 is directed to the fourth management level. Because this feature has already been addressed in claim 2, this claim is rejected for similar reasons to claims 12 and 13.

Claims 19 and 20 recite substantially similar limitations to claims 1 and 2 with the exception that they specify that the claim occurs either after the expiration of a specified warranty period or within a specified warranty period. Hicks further teaches these time frames for filing a claim (see paragraphs 0144-0146). Therefore, these claims are rejected for similar reasons to claims 1 and 2.

Claims 14 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hicks et al., U.S. Patent Application Publication No. 2004/0111379 in view of Barr et al., U.S. Patent No. 5,182,705 and further in view of Luedtke, U.S. Patent Application Publication No. 2003/0018497.

As per claim 14, Hicks in view of Barr teach the method of claim 13 as described above. Hicks does not explicitly teach the use of an approve or deny web page button to indicate claim decisions. Luedtke teaches a method that includes the feature of an approve or deny web page button to approve or deny financial terms of a reinsurance contract (see Figure 6, elements 85 and 86). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Hicks. One of ordinary skill in the art would have

been motivated to incorporate this feature for the purpose of expediting insurance related transactions, such as claim approval or denial, through user friendly interface presentation (see paragraph 0011 of Luedtke).

Claim 17 recites substantially similar limitations to those already addressed in claim 14 with the exception that it is directed to the third management level. Because this feature has already been addressed in claim 1, this claim is rejected for similar reasons to claim 14.

#### **(10) Response to Argument**

In the Appeal Brief, filed 6/5/06, Appellant makes the following arguments:

- A) The Hicks system is not directed to processing claims against a manufacturer's product.
- B) Hicks does not teach accessing the monetary value of the claim.
- C) Hicks and Barr fail to teach approving or denying the claim at the first management level when the monetary value of the claim is below a first predetermined level.
- D) Hicks and Barr fail to teach processing the claim at the second and third management levels based on the monetary value of the claim.
- E) Hicks and Barr fail to teach a fourth management level to review all approved claims for accuracy and completeness and to inform the customer when a claim is denied.
- F) Hicks and Barr are not directed to processing a customer claim against a manufacturer's product for ancillary costs arising from customer expenses associated with the servicing of the product while still within the manufacturer's specified warranty period.
- G) There is no motivation in either Hicks or Barr to combine their teachings.
- H) The combination of Hicks and Barr is based on hindsight reasoning.

I) Combining the automated insurance claims processing operations of Barr with the complex financial transaction business system would not result in a logical and useable system.

Examiner will address Appellant's arguments in sequence as they appear in the Brief.

Argument A:

In response to Appellant's first argument, it is respectfully submitted that this element of the claim is only recited in the preamble and the body of the claim makes no mention of, nor any reference to, a manufacturer's product. Therefore the Examiner interprets this to be merely the intended use of the claimed invention. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Furthermore, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Therefore it is respectfully submitted that limitations directed to a manufacturer, a product, or a manufacturer's product should not be given any patentable weight since no reference is made to any of these elements in the body of the claim. Additionally, it is noted that the only characteristic of the claim, as recited, that is processed in the claims is a "monetary value."

In addition to the above response, even if "a manufacturer's product" is to be given weight, it is respectfully submitted that, given the broadest reasonable interpretation to one of

ordinary skill in the art, Hicks is, in fact, directed to processing a claim against a manufacturer's product. Referring to the abstract of Hicks, certificate authorities (i.e. the manufacturer of digital certificates) issue digital certificates (i.e. the product of the certificate authorities) to customers. Customers can then request warranties as to the veracity of information contained in a digital certificate. Hicks then goes on to teach how warranty claims are processed at paragraphs 0143 to 0154. Therefore, it is submitted that Hicks is directed to processing warranty claims against a manufacturer's (certificate authority) product (digital certificate).

Argument B:

In response to Appellant's second argument, the Examiner respectfully disagrees with this interpretation of the teachings of Hicks. It is noted, for example, that at paragraph [0148] of Hicks, both the root entity and issuing participant are notified of "the filed claim and the amount of the claim." (emphasis added). It is clear, from the context of the Hicks reference, that the amount of the claim is the monetary value of the claim. Therefore, the Examiner respectfully submits that Hicks teaches this aspect of the claims as recited. Furthermore, the system of Hicks would be inoperable without accessing the monetary value of the claim because the system needs to track aggregate warranty claim amounts in order to function (see paragraphs 0128, 0135, and 0136).

Argument C:

In response to Appellant's third argument, the Examiner respectfully disagrees with this interpretation of the teachings of Hicks. Referring again to paragraph [0148], it is clear that the claim is approved or denied by a first management level (i.e. issuing participant level). It is also clear that because the claim has some identified monetary value, as described above in

Art Unit: 3626

response to argument (2), the claim is also below some level. It is also noted that there is no indication in the claim of what the predetermined level is, who or what determines or establishes is, nor how it is determined or established. Therefore, it is respectfully submitted that Hicks teaches this broad limitation as recited.

Argument D:

In response to Appellant's fourth argument, it is respectfully submitted that these limitations are taught by the combination of Hicks and Barr. As described above, Hicks teaches a plurality of management levels (such as the issuing participant level and the WCCM level) that are involved in the processing of warranty claims. In addition, Barr describes a process of routing unpaid claims to different management levels based on claim amounts exceeding predetermined levels (see column 52, lines 45-50). In addition, as described above in response to argument (C), there is no indication in the claim of what the predetermined level is, who or what determines or establishes it, nor how it is determined or established. Therefore, it is respectfully maintained that the combination of Hicks and Barr would have suggested, to one of ordinary skill in the art, these broad limitations as recited.

Argument E:

In response to Appellant's fifth argument, it is first noted that there are no limitations recited in the claims of what constitutes "accuracy and completeness." Therefore, the Examiner has interpreted the teaching in Hicks of the "WCCM" monitoring all approved claims (see paragraphs 0135 and 0152) to meet this limitation. In addition, the Examiner notes that at paragraphs [0149] and [0150], the customer is notified if a claim is denied. It is also noted that at paragraph [0152], if a claim is to be paid to the customer, the relying participant is notified

and then paid. Therefore, it is respectfully maintained by the Examiner that Hicks teaches this limitation as recited in the claims.

Argument F:

In response to Appellant's sixth argument, it is respectfully submitted that these elements of the claims are only recited in the preamble and the body of the claims make no mention of, nor any reference to, when a claim is made nor any ancillary costs. Therefore the Examiner interprets this to be merely the intended uses of the claimed invention. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Furthermore, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In addition, as noted above in response to argument A, even if these additional limitations were to be given weight, Hicks in fact is directed to processing a claim against a manufacturer's product (response to argument A incorporated herein). Furthermore, Hicks specifies that claims may be made within a specified warranty period (see paragraph 0144). Therefore, it is respectfully maintained that the preamble of claim 20 fails to distinguish over the prior art.

Argument G:

In response to Appellant's seventh argument, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is respectfully submitted that Hicks establishes as a goal of the invention to set forth and regulate operation standards and process for the warranty system which includes processing of warranty claims (see paragraph 0072). Therefore, it is respectfully submitted that one of ordinary skill in the art would have looked to other prior art references, such as that of Barr, for useful policies in claims processing.

Argument H:

In response to Appellant's eighth argument, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). As described above in response to argument G, it is respectfully submitted that the teachings of Hicks provides sufficient motivation to incorporate the teachings of Barr as set forth in the rejections above. Furthermore, it is noted that Appellant has merely asserted that the Examiner has relied upon improper hindsight reasoning without providing any further explanation for why this is the case. Therefore, the Examiner respectfully disagrees with Appellant's conclusion.

Argument I:

In response to Appellant's final argument, it is respectfully submitted that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, it is important to note that the Examiner has only relied upon the feature of routing a claim to different management levels based on its monetary value as described in Barr. The Examiner has not attempted to combine the entire teachings of Barr with the entire teachings of Hicks. Given the fact that Hicks is already directed to processing the monetary value of warranty claims, it is submitted that it would not be illogical, as asserted by Appellant, to combine this relatively simple type of processing functionality into the Hicks system. Therefore, the Examiner respectfully disagrees with Appellant's assertion that the combination would not result in a logical and useable system.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Christopher L Gilligan

Art Unit: 3626

Conferees:

J.T.

Joseph Thomas  
Supervisory Patent Examiner  
Tech Center 3600

Hyung Sough   
Supervisory Patent Examiner  
Tech Center 3600

  
JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER